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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,165	12/11/2003	Christian Kissel	K 218	7269

7590 10/20/2006  
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EXAMINER

KOTINI, PAVITRA

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 10/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/733,165

Applicant(s)

KISSEL ET AL.

Examiner

Pavitra Kotini

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-3** are rejected under 35 U.S.C. 102(b) as being anticipated by Weis (US-2845673).

Regarding **claim 1**, Weis discloses a platelet (fig.2, 12) of an elastic bio-compatible material (col.1, lines 66-68; plastics are inherently elastic and can be biocompatible), said platelet being provided with a central H-shaped cut-out so as to form in the platelet a frame structure (fig.2, 17) with tongues (fig.6, 19) extending toward each other and having adjacent front edges (fig.2, 18) forming grasping elements, said tongues extending from said frame structure (fig.6, 19) and said frame structure being curved (fig.2 and fig.3 show arched surface) and elastically biasing said front edges toward each other (fig.6).

The claim preamble “a medical clip” is not given any patentable weight because it does not recite any structure but rather simply states the purpose or intended use of the invention. Moreover, the clip disclosed by Weis is capable of being considered a medical clip if for instance it is used on a surgeon's shoe. Although the clip disclosed by Weis is used to clamp shoelaces instead of tissue, it is within the same problem solving

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area because it meets the structural limitations and is capable of performing the intended use of the claimed invention.

Regarding **claim 2**, Weis discloses said tongues (fig.6, 19) are bent inwardly (if viewing from top of clip) from said curved frame structure (fig.3 shows arched surface).

Regarding **claim 3**, Weis discloses said tongues (fig.6, 19) are bent outwardly (if viewing from underside of clip) from said curved frame structure (fig.3 shows arched surface).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 4** is rejected under 35 U.S.C. 103(a) as being unpatentable over Weis (US-2845673) in view of Kimblad (US-20030153946). Weis discloses the invention substantially as claimed above.

Weis does not disclose the biocompatible material to be of a shape memory material. However, Kimblad teaches a clip made of memory metal such as nitinol (para.0056). This would have the apparent advantage of biasing the clip from a first state to a second state. Therefore, it would have been obvious to a person of ordinary skill in the art to modify the clip disclosed by Wies to be made of the shape memory material taught by Kimblad to gain the advantage stated above.

**Claim 5 and 8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Weis (US-2845673) in view of Esposito (US-3616497). Weis discloses the invention substantially as claimed above.

Weis does not disclose the front edges of the tongues to be serrated or corrugated. However, Esposito teaches the front edges to have a serrated surface (fig.6, 31a) or a corrugated surface wherein there are alternating ridges and grooves in order to have better means of gripping tissue. It is old and well known in the art that having a serrated or corrugated edge would provide better traction. Therefore, it is obvious to a person of ordinary skill in the art to modify the clip disclosed by Weis to include a serrated portion of the tongues as taught by Esposito to gain the advantage of having a better grip.

**Claim 6 and 7** are rejected under 35 U.S.C. 103(a) as being unpatentable over Weis (US-2845673) in view of Perkins (US- 3915361). Weis discloses the invention substantially as claimed above.

Weis does not disclose the tongues to have a non-slip coating or a rough surface. However, Perkins teaches a non-slip coating added to a surface of a clip (col.1, lines 66-67) and a rough surface (claim 1). This surface coating or roughened surface would have the apparent advantage of providing a better frictional surface to preventing slippage between the tongue of the clip and the material that is grasped. Therefore, it is obvious to a person of ordinary skill in the art to modify the clip disclosed by Weis to include a non-slip coating at the contact surface of the clip as taught by Perkins.

**Claims 9-11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Weis (US-2845673) in view of Kimblad (US-20030153946).

Regarding **claim 9**, Weis discloses a platelet (fig.2, 12) of an elastic bio-compatible material (col.1, lines 66-68; plastics are inherently elastic and can be biocompatible), said platelet being provided with a central H-shaped cut-out so as to form in the platelet a frame structure (fig.2, 17) with tongues (fig.6, 19) extending toward each other and having adjacent front edges (fig.2, 18) forming grasping elements, said tongues extending from said frame structure (fig.6, 19) and said frame structure being curved (fig.2 and fig.3 show arched surface) and elastically biasing said front edges toward each other (fig.6).

Weis does not disclose the apparatus for application of said clip. However, Kimblad teaches an apparatus for application of a medical clip comprising of a rod (fig.4, 19) onto which clip can be slipped onto and a sleeve (fig.4, 21) that is movable (para.0057) so that clips can be moved off of the distal end of rod (para.0059). This apparatus would have the apparent advantage of holding the clip substantially in an open state on the rod (the applicant's fig. 4a or 4b are similar to fig. 4 and fig. 7) and pushing the clip off the rod into a closed state. Therefore, it would have been obvious to a person of ordinary skill in the art to utilize the clip disclosed by Weis to be used with the apparatus as taught by Kimblad.

Regarding **claim 10**, Kimblad teaches the rod to be tubular (fig.4, 19).

Regarding **claim 11**, kimblad teaches that this apparatus must be bale to manure through the complex vasculature of the heart (fig.5) and therefore the sleeve (fig.3, 21)

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is the end of a flexible conduit (fig.3, 18) and said rod (fig.3, 19) is axially movably disposed within the flexible conduit and can be controlled remotely (para.00610) in a manner similar to a Bowden control cable because this apparatus taught by Kimblad is a flexible cable (fig.3, 18) that is used to transmit mechanical forces longitudinally by maneuvering the rod (fig.4, 19) which is situated in a hollow conduit (fig. 4, 20).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Yencho et al (US-7108702) discloses a flange with a H-shaped cutout; Pollock et al (US-6517573) and Yencho et al (US-6966920) disclose clips with various shaped cutouts.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pavitra Kotini whose telephone number is 571-272-0624. The examiner can normally be reached on M-F 8:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

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have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Pavitra Kotini  
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**ANH TUAN T. NGUYEN**  
**SUPERVISORY PATENT EXAMINER**

*12/16/06.*